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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,597	02/04/2004	James D. Ralph	SPINE 3.0-447 CONT	3441
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SPINE MP LERNER, DAVID, et al. 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER HOFFMAN, MARY C	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 01/22/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/771,597

Applicant(s)

RALPH ET AL.

Examiner

Mary Hoffman

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Keller et al. (U.S. Patent No. 5,122,130).

Keller discloses an instrument (FIGS. 7-9) for holding an intervertebral spacer, the instrument comprising a shaft having a proximal end (top portion of instrument, see around ref. #26 in FIG. 7) forming a handle, and a distal end forming a claw subassembly (bottom portion); the claw subassembly including a first pincer (ref. #24) which is fixed at the distal end of the shaft and a second pincer (ref. #25) which is pivotally coupled with the first pincer for rotating into and out of spacer holding association with the first pincer; and an actuation mechanism (ref. #28) for selectively rotating the second pincer, wherein the first and second pincers have opposing inner curved surfaces that extend to a distal end of the instrument. The second pincer is spring biased away from the first pincer. The actuation mechanism comprises a sliding member mounted to the shaft which is selectively moveable in the distal direction by a force sufficient to overcome the bias of the spring, the distally directed movement of the sliding member thereby causing the second pincer to pivot toward the fixed first pincer,

and the subsequent retraction of the sliding member in a proximal direction causes the sliding member to disengage the second pincer and the permits the pincers to separate under the bias of the spring. The second pincer includes a tapered surface, which is engaged by a corresponding surface of the sliding member, the engagement causes the second pincer to rotate relative to the first pincer. The first of the pair of pincers is fixed and a second being coupled to the first in open-biased opposition thereto, the first and second pincers having opposing inner curved surfaces that extend to a distal end of the instrument; and a sliding element translatable into and out of engagement with the second pincer to close and open the pair of pincers, respectively. The pair of pincers define an intervertebral spacer grasping enclosure having an access opening through which the intervertebral spacer can be passed for placement into the enclosure when the sliding element is out of engagement with the second pincer; and the spacer is securely maintained between the first and second pincers when the sliding element has been translated into engagement with the second pincer. The first and second pincers are mounted at the distal end of a common shaft, and the sliding element is translatable along the shaft; and wherein the second pincer has a portion thereof which is engaged by the sliding element to are close the pair of pincers. The second pincer is mounted to the common shaft by a pivot joint (see slot separating pincers ref. #24 and #25), and the portion of the second pincer which is engaged by the sliding element is a tapered surface, the angle of which tapered surface, when engaged by the sliding element, causes the second pincer to rotate about the pivot joint, closing the first and second pincers. The reference further discloses an intervertebral spacer (see FIG. 1)

comprising a cylindrical member having an annular groove defining a central axial core portion and a pair of flange portions at opposing ends thereof; and the claw subassembly engages the spacer at the central axial core.

Applicant is reminded that with regard to statements of intended use and other functional statements, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). See also *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koch (U.S. Patent No. 640,308) in view of Yamada et al. (U.S. Patent No. 4,304,157).

Koch discloses an instrument for holding an intervertebral spacer, the instrument comprising a shaft having a proximal end forming a handle (A), and a distal end forming a claw subassembly; the claw subassembly including a first pincer (B) which is fixed at the distal end of the shaft and a second pincer (C) which is pivotally coupled with the first pincer for rotating into and out of spacer holding association with the first pincer; and an actuation mechanism (I) for selectively rotating the second pincer, wherein the first and second pincers have opposing inner curved surfaces that extend to a distal-most end of the instrument. A sliding element (g) is translatable into and out of engagement with the second pincer to close and open the pair of pincers, respectively. The pair of pincers define a grasping enclosure having an access opening through which an intervertebral spacer is capable of being passed for placement into the intervertebral spacer grasping enclosure when the sliding element is out of engagement with the second pincer and is securely maintained between the first and second pincers when the sliding element has been translated into engagement with the second pincer. The first and second pincers are mounted at the distal end of a common shaft, and the sliding element is translateable along the shaft and wherein the second pincer has a portion thereof (d) which is engageable by the sliding element to close the pair of pincers. The second pincer is mounted to the common shaft by a pivot joint pin (e), and the portion of the second pincer which is engaged by the sliding element is a tapered surface, the angle of which tapered surface, when engaged by the sliding element causes the second pincer to rotate about the pivot joint pin, closing the first and second

pincers. A pin (e) extends through the first and second pincers for pivotally coupling the first and second pincers.

Koch discloses the claimed invention except for the pincers being biased outwardly.

Yamada et al. discloses outward biasing in tools to make the tool readily useable without any preparatory procedure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the tool of Koch with pincers biased outwardly in view of Yamada et al. in order to make the tool readily useable without any preparatory procedure.

### ***Response to Arguments***

Applicant's arguments filed 11/02/2007 have been fully considered but they are not persuasive.

Applicant argues that the first pincer of Keller is not "fixed" to the distal end of the shaft. The examiner respectfully disagrees, because the term "fixed" does not mean immovable relative to the shaft, as suggested by Applicant. The term "fixed" can merely mean "attached" and the first pincer is clearly attached to the distal end of the shaft.

Applicant also argues that the second pincer does not rotate into and out of spacer holding association with the first pincer. The examiner respectfully disagrees, because the second pincer and first pincer of Keller clearly rotate relative each other in

order to hold an intervertebral implant. The slot between the pincers allows for the pivoting movement caused by the elastic deformation of the pincers toward each other.

Regarding the Koch reference, Applicant argues that the reference fails to disclose the pincers being biased and opposing inner curved surfaces that extend to a distal-most end of the instrument. The Koch reference has been combined with the teaching of Yamada et al. to incorporate biasing of the pincers. The examiner respectfully disagrees that the opposing inner curved surfaces do not extend to a distal-most end of the instrument. In the Koch reference, the distal-most end is being considered the "extraneous flat surface" (as described by Applicant in his remarks filed 11/02/2007, page 7). Thus, the opposing inner curved surfaces clearly extend to the extraneous flat portion at the distal-most end of the instrument.

The rejections are deemed proper.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



EDUARDO C. MARTINEZ  
SENIOR PATENT EXAMINER